

REMARKS

This application has been reviewed in light of the Office Action dated January 14, 2003. Claims 23-27 are presented for examination. Claims 23, 26, and 27, which are the independent claims, have been amended to define still more clearly what Applicants regard as their invention. Favorable reconsideration is requested.

Claims 23-27 were rejected under the judicially created doctrine of obviousness type double patenting in view of this application's parent, U.S. Patent No. 6,301,016 (which issued from Application No. 08/352,883). Applicants submit that this rejection is improper under 35 U.S.C. § 121, because the present application is a division of its parent, and was filed due to a restriction requirement in the parent. In support of this position, Applicants attach herewith a copy of the restriction requirement from the parent case. Claims 23-27 of this application correspond to non-elected Claims 31-34 and 39 of Group V, which were cancelled in the parent in response to the restriction requirement. Accordingly, Applicants respectfully request withdrawal of the double-patenting rejection.

Claims 23-27 also were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,978,097 (Ueno). Applicants respectfully traverse this rejection.

Applicants submit that amended independent Claims 23, 26, and 27, together with the remaining dependent claims, are patentably distinct from Ueno for at least the following reasons.

Claim 23 requires a data processing apparatus connectable to a LAN, including an input unit, an identification unit, a transfer unit, and a generation unit. The input unit is adapted to input data. The identification unit is adapted to obtain user information about a user for whom the data inputted by the input unit was received. The transfer unit is adapted to transfer the data inputted by the input unit to a terminal connected to the LAN. The generation unit is adapted to generate a predetermined signal, based on the user information obtained by the identification unit, to notify the user that the data has been transferred by the transfer unit.

Important features of Claim 1 are that the identification unit is adapted to obtain user information about a user, and the generation unit is adapted to generate a predetermined signal, based on the user information obtained by the identification unit, to notify the user that the data has been transferred by the transfer unit. Support for these features can be found in the specification at least at page 9, line 19, to page 10, line 1, which is described in reference to Figure 3. This portion of the specification states, in part, that "sender information . . . that has been received . . . is analyzed and set as a sending user name (step S301)." Further support can be found at least at page 18, line 18, to page 19, line 7, which is described in reference to Figures 1-4. This portion of the specification states, in part, that "[a]fter the completion of the receiving operation, the server machine 103 sends a reception-report mail to the user who sent the data so as to report that the received image data file has been printed by means of remote printing on a printing apparatus 106 connected to the LAN 100. That is, in step S407, the LAN-FAX 101

produces reception report information based on the sender information obtained in step S301, and sends it to the server machine 103 (step S408).” In other words, the LAN-FAX receives sender information and produces a reception report based on the sender information. (It is to be understood that the scope of Claim 23 is not limited to the details of this embodiment, which is referred to only for purposes of illustration.)

As a disclosure of an identification unit according to Claim 23, the Office Action points to step #12 of Ueno’s Figure 2. However, Ueno states that “[i]n step #12, it is determined whether or not the apparatus is called” (col. 3, lines 44-46). Applicants note that this is the only description of step #12 that they have found in Ueno. Applicants submit that merely detecting whether the apparatus is called is not equivalent to or suggestive of the obtaining of user information, as is required by the identification unit in Claim 23. For example, merely detecting a call would not provide enough information to generate a report to notify a user that data has been transferred. Accordingly, Applicants submit that one of ordinary skill in the relevant art would find nothing in Ueno that would teach or suggest the identification unit adapted to obtain user information about a user for whom the data inputted by the input unit was received, as claimed in Claim 23.

As a disclosure of a generation unit according to the present invention, the Office Action points to column 4, lines 9-60 of Ueno, which refers to Figure 2. To elaborate, Ueno states that “[a]fter the transfer of the data, the display 34 displays data denoting the transfer destination” (col. 4, lines 29-30). However, the data denoting the transfer destination is understood to be data selected by the machine from a preset list of

destination facsimiles, and is not understood to be user information obtained by an identification unit. (See col. 3, lines 26-41, and col. 4, lines 38-40). Further, Applicants understand Ueno merely to disclose displaying the transfer destination on the display 34, and is silent regarding generating a message based on obtained user information.

Accordingly, Applicants submit that one of ordinary skill in the relevant art would find nothing in Ueno that would teach or suggest the generation unit adapted to generate a predetermined signal, based on the user information obtained by the identification unit, to notify the user that the data has been transferred by the transfer unit, as claimed in Claim 23.

Based at least on the above reasons, Applicants submit that Claim 23 is patentable over Ueno and respectfully request withdrawal of the rejection under 35 U.S.C. § 102(e).

Independent Claims 26 and 27 are method and computer storage medium claims, respectively, that correspond to apparatus Claim 23, and are believed to be patentable for at least the same reasons as discussed above in connection with Claim 23.


The other rejected claims in this application depend from Claim 23 and, therefore, are submitted to be patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

This Amendment After Final Action is believed clearly to place this application in condition for allowance and, therefore, its entry is believed proper under 37 C.F.R. § 1.116. Accordingly, entry of this Amendment After Final Action, as an earnest effort to advance prosecution and reduce the number of issues, is respectfully requested. Should the Examiner believe that issues remain outstanding, it is respectfully requested that the Examiner contact Applicants' undersigned attorney in an effort to resolve such issues and advance the case to issue.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and the allowance of the present application.

Applicants' undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,


Attorney for Applicants
~~Lock See Yu-Jung~~
Registration No. 38,667

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

NY_MAIN 323495v1

RECEIVED
OCT 26 1997



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/70021983	12/03/94	MAISON MARTIN MARGIELA	K 05-11082

25M2/1015
FITZPATRICK CELIA HARPER AND SCINTO
277 PARK AVENUE
NEW YORK NY 10172

EXAMINER

LEE C
ART UNIT PAPER NUMBER

2615 10
DATE MAILED: 10/16/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 7-11-97
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire ONE (1) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-4, 6-18, 20-29, and 31-45 is/are pending in the application.
- ☐ Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-4, 6-18, 20-29, and 31-45 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-848.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

—SEE OFFICE ACTION ON THE FOLLOWING PAGES—

Serial Number: 08/352,883

Page 2

Art Unit: 2616

I. This application contains claims directed to the following patentably distinct species of the claimed invention:

I. Claims 1, 2, 6, 7, 16-18, 20, 23, 24, 27, 28 and 36, directed to an apparatus, method, or computer program, wherein a memory stores information identifying the apparatus to which data has been transferred after an error state of the apparatus itself has been detected.

II. Claims 3, 4, 25, 26, 35, and 40, directed to an apparatus, method, or computer program which transfers data in an order based on attribute of the data.

III. Claims 8, 9-11, 21, 37, and 41, directed to specific technique of LAN-error detection.

IV. Claims 12-15, 22, 29, 38, and 42-45, directed to process mode setting based on process command(s) received in a packet by receiving means.

V. Claims 31-34 and 39, directed to generating a signal to notify a user, for whom data was received, that the data has been transferred.

Note that the above species I to V correspond to different embodiments of the invention referring to different figures.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable

Serial Number: 08/352,883

Page 3

Art Unit:

thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee at telephone number (703) 305-4867, art unit fax no. (703) 308-5397, or supervisory patent examiner Edward Coles at (703) 305-4712. The group receptionist can be reached at (703) 305-3900.



C. Lee

October 11, 1997